

Serial No. 10/643,885

Attorney Docket No. 52493.000344

REMARKS

Claims 1-25 are pending. In this Amendment, claim 1 is amended to further recite novel features of the claimed invention and for clarity.

No new matter has been added by this Amendment.

Reconsideration of the outstanding rejections in the present application are requested based on the following remarks.¹

A. APPLICANT'S REFERENCED PRIOR COMMUNICATIONS

On the cover page, the Office Action refers to Applicant's communication of 12-28-10. Further, on page 2, the Office Action refers to Applicant's submission of 3-6-2009 (Office Action page 2, line 7). Applicant respectfully submits that such referenced communications are misplaced and are not understood - in that Applicant's prior Response was filed June 18, 2010. Applicant respectfully requests clarification of the record.

B. THE PRIMARY REJECTION UNDER 35 U.S.C. § 103(a)

In the Office Action, claims 1-9, 13-16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al (U.S. 5,986,568) in view of Ridgeway (U.S. 5,967,975). This rejection is traversed.

In paragraphs 3 and 4, the Office Action sets forth that various of Applicant's arguments are rendered moot in view of the new grounds of rejection.

The features of claim 1 are set forth above.

¹ As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., assertions regarding dependent claims, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

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The Office Action sets forth various alleged teachings of Suzuki.

The Office Action further admits deficiencies of Suzuki. In particular, on page 4, lines 5-11, the Office Action asserts:

Suzuki does not teach disposing a data input portion in the home of the claimant such that the data input portion is **disposed in the home of the claimant continuously over a period of time inclusive of a plurality of visits of the caregiver**, and such that over such period of time the data input portion is retained by the claimant in the home of the claimant and not retained by the caregiver, and **during such period of time data is collected by the data input portion by interfacing with the caregiver**, and such data is transferred from the data input portion.

(emphasis added)

The Office Action attempts to cure the deficiencies of Suzuki with the teachings of Ridgeway. The Office Action, on pages 4-5, asserts:

Ridgeway teaches a subscriber remote station with health parameter monitoring devices that are self-monitored at home (see for example Ridgeway column 6 lines 1-12 and Fig. 1). Ridgeway further teaches the preferred design embodiment described herein incorporates well known security system apparatus into the design of a "subscriber remote station" which accepts "normal" and "in-alarm" electrical signal inputs from health parameter measurement devices, and responsively transmits corresponding messages to a typical security system central station, programmed to alarm monitor for "in-alarm" measurements, and to assure that all in-home health parameter monitoring activities are performed within prescribed time windows. The central station's computer also automatically creates and stores a data record for each health parameter measurement. Printouts of such data records can provide physicians with an accurate chronology of in-home health parameter measurement activities, with **no possibility of patient manipulation** of stored data (Ridgeway column 3 lines 51-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to **combine the teachings of Suzuki and Ridgeway**. The well known elements described are merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

(emphasis added)

Applicant submits that the basis of the rejection is deficient.

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As set forth in M.P.E.P 706.02(j), 35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. M.P.E.P 706.02(j) indicates that after indicating that the rejection is under 35 U.S.C. 103, the Examiner should set forth in the Office Action:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,
- (B) the difference or differences in the claim over the applied reference(s),
- (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
- (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

M.P.E.P. 706.02(j) references the well known requirements of *Graham v. John Deere*. Further, M.P.E.P 706.02(j) notes that it is important for an Examiner to properly communicate the basis for a rejection so that the issues can be identified early and the Applicant can be given fair opportunity to reply.

As acknowledged in the Office Action and set forth above, Suzuki does not teach disposing a data input portion in the home of the claimant such that the data input portion is disposed in the home of the claimant continuously over a period of time inclusive of a plurality of visits of the caregiver, and such that over such period of time the data input portion is retained by the claimant in the home of the claimant and not retained by the caregiver, and during such period of time data is collected by the data input portion by interfacing with the caregiver.

While Ridgeway is alleged to cure the deficiencies of Suzuki, Applicant submits that Ridgeway indeed fails to cure such acknowledged deficiencies. Indeed, Ridgeway is not even alleged to teach such features - so as to cure the deficiencies of Suzuki.

In particular, Ridgeway fails to teach the recited features related to interface with the caregiver. Accordingly, since the Office Action acknowledges that Suzuki fails to

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teach such features, and the Office Action does not even allege that Ridgeway teaches such features (so as to cure the deficiencies of Suzuki), Applicant submits that the rejection under 35 U.S.C. 103 is clearly deficient.

In further explanation of the deficiencies of the rejection, claim 1 recites:

disposing a data input portion in the home of the claimant such that the data input portion is disposed in the home of the claimant continuously over a period of time inclusive of a plurality of visits of the caregiver, and such that over such period of time the data input portion is retained by the claimant in the home of the claimant and **not retained by the caregiver**, and during such period of time data is **collected by the data input portion by interfacing with the caregiver**, and such data is **transferred** from the data input portion, while disposed in the claimant's house, to the servicing entity in accord with the relationship of the claimant with a servicing entity, and during such period of time the data input portion is used to document only care of the single claimant;

the data input portion interfacing with the caregiver prior to the caregiver providing a service to the claimant so as to input a first data set into the data input portion;

Accordingly, claim 1 recites that "data is collected by the data input portion by interfacing with the caregiver, and such data is transferred from the data input portion, while disposed in the claimant's house, to the servicing entity in accord with the relationship of the claimant with a servicing entity ..." Thus claim 1 recites both the collection of data from the caregiver AND the transfer of that data to the servicing entity. Suzuki is acknowledged as failing to teach such features, and Ridgeway fails to cure such deficiencies of Suzuki.

The rejection is deficient on further grounds. As set forth above, the Office Action acknowledges that Suzuki does not teach disposing a data input portion in the home of the claimant such that the data input portion is disposed in the home of the claimant continuously over a period of time inclusive of a plurality of visits of the caregiver. In contrast, Applicant's invention is very much directed at disposing the data input portion in

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the home of the claimant and the various related features. In order to cure the deficiencies of Suzuki, the Office Action (on page 4, lines 3-8 and as also set forth above) asserts:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Suzuki and Ridgeway. The well known elements described are merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

(emphasis added)

Applicant traverses such conclusory statements as failing to support the 35 U.S.C. 103 rejection. The Office Action essentially proposes to change the teachings of Suzuki in a fundamental manner. That is, the Office Action proposes to basically convert Suzuki from a first system as acknowledged by the Office Action (that does not utilize a data input portion disposed in the home of the claimant such that the data input portion is disposed in the home of the claimant continuously over a period of time inclusive of a plurality of visits of the caregiver) - to a second system that does utilize such a data input portion disposed in the home of the claimant. Applicant submits that such cannot in any manner be considered merely a "combination" of the teachings of Suzuki with Ridgeway. Rather, Applicant submits that such is modifying Suzuki in a very fundamental manner. Applicant submits that the one of ordinary skill in the art would not have been so motivated. At the very least, the Office Action fails to set forth any reason that the one of ordinary skill would have been so motivated to change Suzuki in such a fundamental manner.

Relatedly, Applicant submits that the Office Action has failed to satisfy the *Graham v. John Deere* analysis as set forth above. That is, the Office Action's general proposal to "combine" fails to set forth, in any reasonable manner, the particular manner in

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which the Examiner is proposing to modify Suzuki with which particular teachings of Ridgeway. Clarification or withdrawal is appropriate.

For at least these reasons, independent claim 1, as well as the various dependent claims, are patentable over Suzuki and Ridgeway. Therefore, Applicant will not address further argument with respect to such dependent claims and reserves the right to address these arguments at a later time. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. 103 be reconsidered and withdrawn.

C. REJECTION OF CLAIMS 10 and 24 UNDER 35 U.S.C. §103

Claims 10 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki in view of Ridgeway and U.S. Patent 7,107,285 to von Kaenal *et al.* ("von Kaenal"). *Office Action*, paragraph 21. This rejection is traversed.

Since claim 10 is dependent on allowable independent claim 1, dependent claim 10 is allowable as well.

Regarding independent claim 24, since claim 24 contains similar limitations as argued above with respect to independent claim 1, e.g., a data input portion disposed in the home of the claimant, and since von Kaenal does not cure the deficiencies of Suzuki, claim 24 is allowable for similar reasons asserted above with respect to claim 1.

Therefore, the undersigned representative will not address further argument with respect to claims 10, 12, and 24 and reserves the right to address these arguments at a later time. Withdrawal of the rejection of claims 10, 12, and 24 is requested.

D. REJECTION OF CLAIMS 11 and 20-23 UNDER 35 U.S.C. §103

Claims 11 and 20-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki in view of Ridgeway and U.S. Patent 7,124,112 to Guyan *et al.* ("Guyan"). This rejection is traversed.

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Since claim 11 is dependent on allowable independent claim 1, dependent claim 11 is allowable as well.

Regarding independent claim 20, since claim 20 contains similar limitations as argued above with respect to independent claim 1, e.g., a data input portion disposed in the home of the claimant, and since Guyan does not cure the deficiencies of the applied art as discussed above, claim 20, as well as dependent claims 21-24, are allowable for the same reasons asserted above with respect to claim 1.

Therefore, the undersigned representative will not address further argument with respect to claims 11 and 20-23 and reserves the right to address these arguments at a later time. Withdrawal of the rejection of claims 11 and 20-23 is requested.

E. REJECTION OF CLAIM 12 UNDER 35 U.S.C. §103

Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over Suzuki in view of Ridgeway and Guyan and U.S. Patent 7,107,285 to von Kaenal *et al.* ("von Kaenal"). *Office Action*, paragraph 29. This rejection is traversed. Since claim 12 is dependent on allowable independent claim 1, dependent claim 12 is allowable as well.

Therefore, the undersigned representative will not address further argument with respect to claim 12 and reserves the right to address these arguments at a later time. Withdrawal of the rejection of claims 10, 12, and 24 is requested.

F. REJECTION OF CLAIM 17 UNDER 35 U.S.C. §103

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki in view of Ridgeway and U.S. Patent 5,357,427 to Langen *et al.* ("Langen"). *Office Action*, paragraph 31. This rejection is traversed.

Since claim 17 is dependent on allowable independent claim 1 and since Langen does not cure the deficiencies of the applied art with respect to claim 1, dependent claim

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17 is allowable as well. Therefore, the undersigned representative will not address further argument with respect to claim 17 and reserves the right to address these arguments at a later time. Withdrawal of the rejection of claim 17 is requested.

G. REJECTION OF CLAIM 25 UNDER 35 U.S.C. §103

Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki in view of Ridgeway and von Kaenal and in view of Guyan. *Office Action*, paragraph 33. This rejection is traversed.

Since claim 25 is dependent on allowable independent claim 24 and since the applied art does not cure the deficiencies of the applied art with respect to claim 24, dependent claim 25 is allowable as well. Therefore, the undersigned representative will not address the arguments with respect to claim 25 and reserves the right to address further argument at a later time. Withdrawal of the rejection of claim 25 is requested.

H. CONCLUSION

The foregoing is submitted as a full and complete Response to the pending Office Action. Favorable consideration of the claims is requested. If the Examiner believes any informalities remain in the application which may be corrected by Examiner's Amendment, or if there are any other issues which may be resolved by telephone interview, a telephone call to the undersigned attorney at (703)714-7449 is respectfully solicited.

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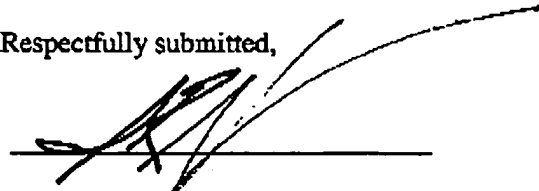
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Dated: June 28, 2011

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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'James R. Miner', is written over a horizontal line.

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